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FAX TRANSMISSION**DATE:** May 28, 2008**PTO IDENTIFIER:** Application Number 10/537,224-Conf. #3427
Patent Number**Inventor:** Michael Scherer et al.**MESSAGE TO:** US Patent and Trademark Office**FAX NUMBER:** (571) 273-8300**FROM:** FULBRIGHT & JAWORSKI L.L.P.

C. Andrew Im

PHONE: (212) 318-3359**Attorney Dkt. #:** NY-RPP 201-US (10505883)**PAGES (Including Cover Sheet):** 5**CONTENTS:** Response to Restriction Requirement (with Traverse)
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Application No. (if known): 10/537,224

Attorney Docket No.: NY-RPP 201-US

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Response to Restriction Requirement (with Traverse) (2 pages)

Application No.: 10/537,224

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MAY 28 2008

Docket No.: NY-RPP 201-US
(PATENT)

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Dated: May 28, 2008

Signature:

(Fani Malikouzakis)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael Scherer et al.

Application No.: 10/537,224

Confirmation No.: 3427

Filed: December 3, 2003

Art Unit: 1795

For: METHOD FOR PRODUCING A
MULTILAYER COATING AND DEVICE
FOR CARRYING OUT SAID METHODS

Examiner: Not Yet Assigned

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Restriction Requirement set forth in the Office Action mailed April 28, 2008, applicant hereby provisionally elects Group I, claims 55-91 for continued examination, with traverse.

The Examiner has required restriction between Group I, claims 55-91; Group Group II, claims 92-107 and Group III, claim 108 because allegedly the inventions are distinct from each other. Applicants respectfully traverse the Examiner's Restriction

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Application No.: 10/537,224

Docket No.: NY-RPP 201-US

Requirement on the grounds that all of the claims 55-108 are related and essentially describe producing a coating. It is urged that Groups I, II and Group III are at best, different embodiments of a single inventive concept for which a single patent should issue. These Groups do not constitute distinct inventions such as to require that their subject matter be prosecuted in separate application. Further, there is no extra burden on the Patent and Trademark Office to examine the allegedly separate invention in a single patent application.

Moreover, Group II comprises apparatus claims for producing a coating and Group III comprises single coating product claim, which are essentially equivalent to the method claims of Group I for producing a coating. It is believed that a different classification of the method and apparatus claims does not preclude inclusion of both form of claims in the same application. As stated in the decision of the Board of Appeals in Ex parte McGowan, (64 U.S.P.Q. 429), "...different classification of apparatus ... and a method ... do not appear to be pertinent to the question of division between such similar inventions as are covered by appellant's claims."

The Commissioner may require restriction if two or more independent and distinct inventions are claimed in a single application (37 C.F.R. § 1.142(a)). In the present case, although the claimed subject matter may be classified in different classes, the inventions are not independent.

If the Examiner is aware of another method to make the product as claimed, using a process which is materially different from that set forth in the restricted claims, applicant respectfully requests the Examiner to substantiate his position in greater detail. Otherwise, it is respectfully requested that the restriction requirement be withdrawn, and that each of claims 55-108 presently pending in this application be examined.

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Application No.: 10/537,224

Docket No.: NY-RPP 201-US

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In view of the above comments, it is respectfully requested that the Examiner withdraw the restriction requirement and allow applicants to prosecute the entire application in the present case. In the event the restriction requirement is made final, applicant reserves the right to file one or more divisional applications directed to the non-elected subject matter.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-RPP 201-US (10505883) from which the undersigned is authorized to draw.

Dated: May 28, 2008

Respectfully submitted,

By 

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Registration No. 40,657

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